

## **REMARKS**

Applicants wish to thank the Examiner for the interview conducted with the Examiner on November 3, 2005 regarding the new matter rejection in the Office Action mailed on September 15, 2005. The current amendments to the specification and claims were proposed to avoid adding new matter to the application. At the conclusion of the interview, the Examiner agreed that the proposed amendments would overcome the new matter rejections.

The Specification and Claims 1-3, 5, and 7-8 have been amended. Claims 9-16 have been added. Applicants submit that the amendments made herein are fully supported in the specification, claims and the drawings, as originally filed, and therefore no new matter has been introduced. Claims 1-16 are pending in the present application and are respectfully submitted for reconsideration.

### **I. The Amendments are Fully Supported by the Original Application**

The current amendment to use the term "physical" position data is fully supported in the original application. Throughout the specification, claims and figures, the original application described an e-mail system attaching directions to the physical location of a place such as restaurants, festivals, buildings, hot springs, and driving courses.

#### **A. Support in the Written Description**

The written description discloses that the position data to be attached to an e-mail is physical in nature. On Page 8, Lines 11-13, the positional data is defined as including the "spot name . . . , position coordinate, address, phone

number, postal code, and additional data for explaining the relevant place.”

Position coordinates were described on Page 7 lines 14-21 as longitude and latitude data corresponding to map images, “such as a map image of the whole of Japan, and map images of each prefecture.” Thus, the positional data is physical in nature. The data gives information about finding the actual “physical” location of the desired place.

The amendments to the specification to add “physical” to Lines 9 and 11 of Page 8, merely clarify the term as it is used in the claims. It does not add new matter to the specification. Instead, the term “physical position data” has the same definition in the specification as the original term “position data”. They both have been defined to include the list of information originally included in the specification on Page 8 Lines 11-13.

The amendment to the specification to add “physical” to Page 7 Line 14 does not add new matter to the specification. The addition merely clarifies that the term used in the claim includes latitude and longitude coordinates for a physical map as originally described on Page 7 in Lines 14-18.

#### B. Support in the Figures

The amendment is further supported by Figures 9, 10, 12-17, and 20-23. Each of the figures show a “physical” location to be attached to the e-mail. The names of physical locations such as restaurants, festivals, buildings, hot springs, and driving courses are exemplified. Furthermore, Figure 9, 12, 15, and 22 show the position data attached as addresses, phone numbers, and map coordinates. Figure 10 shows a version where the spot is selected by map location.

All of the position data exemplified in the figures is “physical” position data for an actual place to be physically visited. The figures are exactly in line with the definition in the specification on Page 8 Lines 11-13 which describe the positional data to be attached as “spot name . . . , position coordinate, address, phone number, postal code, and additional data for explaining the relevant place.” The figures support the amendment to clarify the term “positional data” by adding the term “physical”.

The amendments are fully supported in the original application. Therefore, entry of these amendments and reconsideration is requested.

II. The “Physical Positional Data” in Claims 1-8 Does Not Encompass Electronic Addresses

The present invention claims an e-mail sending and receiving system comprising “a positional data attaching section for attaching one or more of the physical positional data stored in the positional data storage section to the e-mail message generated by the mail generating section.” Physical positional data is explained on Page 8 Lines 11-13 to include the “spot name . . . , position coordinate, address, phone number, postal code, and additional data for explaining the relevant place.”

Position coordinates were described on Page 7 lines 14-21 as longitude and latitude data corresponding to map images, “such as a map image of the whole of Japan, and map images of each prefecture.” Thus, the positional data is physical in nature. The data gives information about finding the actual “physical” location of the desired place.

The prior art reference previously applied in 35 U.S.C. § 102(b) rejections of claims 1-8 was Kuzma (U.S. Patent No. 5,781,901), hereinafter "Kuzma". Kuzma teaches an e-mail system which attaches a URL or electronic network address to an e-mail. Kuzma does not teach attaching information about the physical location of a desired place to the e-mail. Thus, Kuzma cannot anticipate claims 1-8. Kuzma is similar to the prior art described in the Background of the Invention and has the drawbacks associated with such prior art. (See Page 2 Lines 7-18). The present invention is designed to overcome the obstacles connected with merely attaching a URL to an e-mail.

In addition to the written description, the claims differentiate between the physical type of positional data to be attached to e-mails in claims 1-8 and other types of location information such as a network address.

A. The Claims Distinguish Physical Positional Data and a URL

The claims also distinguish between "physical" positional data and electronic network addresses. Claim 5 states that in addition to the physical positional data, the e-mail may further comprise an attachment for receiving detailed data about the location by "attaching a URL for accessing the detailed data to the e-mail message." (See Claim 5). The URL is described as an attachment for accessing additional information, rather than the positional data about the desired locations in the email. The claim language in Claim 5 distinguishes a URL or electronic positional data from the physical positional data claimed in Claims 1-4 and 6-8.

The original application consistently describes an e-mail sending and receiving system which is configured to attach descriptions of the physical location of desired places.

Applicants have responded to the new matter rejection by amending the language as discussed in the interview with the Examiner on November 3, 2005.

Applicants respectfully submit that Kuzma does not anticipate Claims 1-16. Accordingly, Applicants respectfully request withdrawal of the new matter rejection and the prior art rejection and consideration of allowance of Claims 1-16.

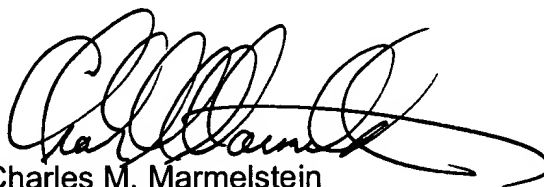
### Conclusion

For all of the reasons set forth above, Applicants respectfully submit that each of claims 1-16 recites subject matter that is neither disclosed nor suggested in the applied art of record. Applicants therefore respectfully request that claims 1-16 be found allowable and that this application be passed to issue.

If for any reason, the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact the Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper has not been timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300 referencing Attorney Docket No. 107439-00027.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Charles M. Marmelstein', with a long, sweeping horizontal flourish extending to the right.

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